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REMARKS

The Claims under consideration remain Claims 1, 2, 4-6, 8-10, 14-19, and 21-25. Reconsideration of the final rejection of all claims is respectfully requested for the reasons set forth herein.

The Detailed Action of 29 June 2005 will be addressed with reference to any paragraph numbers or subject matter headings contained therein.

Examiner Interview Summary

A telephonic interview was conducted between Applicants' undersigned attorney and Examiner Jacqueline Stephens on 29 July 2005. The §112 rejections were discussed. The Examiner stated that she does not see a better mode of definition for the claims and that the §112, first paragraph, rejections would be maintained. No prior art references were discussed. Applicants' undersigned attorney thanks the Examiner for the courtesy shown him during their interview.

Claims Rejections 35 USC § 112

Per paragraph 5 of the Detailed Action, Claims 1, 2, 4-6, 8-10, 14-19 and 21-25 are rejected under 35 USC § 112, first paragraph, as containing subject matter not sufficiently described in the specification, owing to: "The test procedures for determining a Young's modulus and a modulus of elasticity as recited in claims 1, 8, and 9 are not enabled by the disclosure. The test characteristics cited in the application do not include the test procedures."

Applicants again respectfully traverse, believing that the bases for objections to the specification as are incorrect. Applicants had previously extensively discussed this enablement issue in their Amendment C of 04 November 2004, incorporated herein by reference, and as further discussed below.

The term "Young's modulus" is used in Claims 1, 8, and 9. The term "modulus of elasticity" was previously used in Claim 9. The two terms are equivalent, as shown in the definition listings of Amendment C, Appendix A (of record). Further, per the *Dictionary of Fiber & Textile Technology*, Kosa, 1999, as in Amendment C, Appendix A, Young's modulus is the ratio as calculated from the stress expressed in

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force per unit cross sectional area, and the strain expressed as a fraction of the original length. Modulus so calculated is equivalent to the force required to strain the sample 100% of its original length, at the rate prevailing below the elastic limit.

Because Young's modulus defines what is to be measured (stress and strain); and the specification sets forth, at page 30, line 4, how the strain was induced; it is respectfully submitted that one of ordinary skill in the art would easily understand the determination of Young's modulus as set forth in the specification and the claims of the present invention and that no undue experimentation would be required to make and use the present invention. The Applicants, per their Amendment C, also amended the testing description to make clear that the claimed subject matter was derived from the tests as described in the specification. Applicants again assert that those of ordinary skill would understand with reasonable certainty how to practice the present invention.

Accordingly, all rejections based upon the Detailed Action's incorrect determination of "non-enablement" with respect to test procedures are still believed to be obviated and are respectfully requested to be withdrawn.

Per paragraph 6, of the Detailed Action, Claims 1, 2, 4-6, 8-10, 14-19 and 21-25 are rejected under 35 USC § 112, first paragraph: "because the specification, while being enabling for the embodiments taught in examples 1 and 2 on page 26 of the disclosure, does not: "reasonably provide enablement for other types of materials or combinations of construction." and further: "fails to teach one of ordinary skill in the art the exact film needed or the exact process for forming the nonwoven web to provide the claimed test results. [emphasis added]" Applicants traverse these rejections.

The Detailed Action has not provided sufficient evidence or reasoning to rebut the strong presumption that the specification is adequate to support the claimed invention. Instead, the Detailed Action has imposed an undue burden upon the Applicants to inform the public of every material meeting the claim language.

Per the Detailed Action at page 2, paragraph 1, the Detailed Action relies on *Ex parte Slob*, 157 USPQ 172 (Patent Office Board of Appeals 1967); for the proposition that:

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"[the] claims set forth the physical characteristics desired of the material in the containment flap rather than the specific composition and structure of the flap in the end product. Therefore, relying on *Ex parte Slob*, 157 USPQ 172, such claims could cover any conceivable combination of materials ... which would impart the desired characteristic, i.e. the claims are too broad and indefinite... For these reasons, the Examiner concludes the specification fails to teach how to make and use the claimed invention ..."

The holding of *Ex Parte Slob* improperly relies on dicta from *Austenal Labs Inc. v. Nobilium Processing Company of Chicago*, 115 USPQ 44, (ND Ill. 1957). The actual basis of the holding in *Austenal* appears to be more succinct: "the evidence clearly shows that it is impossible to produce commercially acceptable patterns according to the teachings of the patent in suit." *Austenal (Id.)* This is not analogous to the fact situation in the present application with its enabling examples of material.

Case law from higher authority which is more clearly analogous to the present set of facts exists. As stated by the U.S. Court of Customs and Patent Appeals: "where the chemical identity of a material is not critical, we see no reason why an applicant should not be permitted to define that material partly in terms of its physical properties or the function which it performs." *In Re Kenneth A. Metcalfe and William H. Lowe*, 161 USPQ 789 (CCPA 1969).

In a case distinguishing *Austenal* on its facts, the U.S. Court of Customs and Patent Appeals notes:

"On the first point, the tacitly assumed need for exemplification, we do not regard §112, first paragraph, as requiring a specific example of everything with the scope of a broad claim. There is no question raised as to the fact that there are specific examples of what appears to be the preferred embodiment and best mode contemplated by the applicant of carrying out his claimed invention; we are here dealing only with a possible alternative embodiment within the scope of the claims. What the Patent Office is here apparently attempting is to limit all claims to the specific examples, notwithstanding the clear disclosure of a broader invention. This it may not do." *In the Matter of the Application of Robert J. Anderson*, 176 USPQ 331 (CCPA 1973).

It is respectfully submitted that the structure and function of the present invention are more than adequately explained to enable a person having ordinary skill in the present art to make and use the claimed invention(s). The structure to achieve the

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different Young's Modulus in different axes, and the functional benefits from such structure, are all adequately explained in the specification. When the nature of the invention, the state of the prior art (such as cited by the Applicant at pages 25 of the specification with respect to the making of films and nonwovens); the level of one of ordinary skill, and the level of predictability in the art are all properly considered, it is clear that a laundry list of further examples for "other types of materials and combinations of construction," or setting forth "exact film" or "exact process for forming the nonwoven" is not necessary for persons having ordinary skill in the art to avoid undue experimentation to practice the present invention. This is especially apparent with respect to the highly specific limitations of the dependent Claims 4, 5, 17-19, and 21-24. Analogously, the CCPA has stated: "the only "undue burden" which is apparent to us in the instant case is that which the Patent Office has attempted to place on the appellant. The Patent Office would require him to do research on the "literally thousands" of [compounds] that are suitable for incorporation into his claimed combination ..." *In Re Charles T. Fuetterer*, 138 PQ 217 (CCPA 1962).

Further, the Detailed Action evidences a confusion or commingling of over-breadth and enablement rejections. If the claims are too broad, a proper basis of the rejection would be §102 or §103; not §112. Applicants see no valid contention that the specification fails to enable practice of the invention or lacks a best mode. The contention of the Detailed Action is only that the specification fails to explicitly teach every imaginable embodiment of the invention.

Applicants note that it has long been settled in the law that the specification need not teach every conceivable embodiment encompassed by the claims. It is further well settled law that Applicants are not required to provide an exact manufacturing specification of the type apparently being required by the Examiner in the present instance. It is therefore believed that the basis of the rejections is not within the scope of the law (or sound public policy) and that the present rejections must be withdrawn.

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Accordingly, all rejections based upon the Detailed Action's incorrect determination of "non-enablement" or the like under § 112, first paragraph, are requested to be withdrawn.

Claims Rejections 35 USC § 103

Per paragraph 9 of the Detailed Action, Claims 1, 2, 4 and 8 stand rejected as obvious over McCormack, US Patent 5,855,999 (hereinafter "McCormack").

As previously discussed, while Applicants cited McCormack as an example of breathable film types generally suitable for use as a starting point with the present invention, it is respectfully noted that Applicants clearly teach that, in the context of the present invention, any breathable films used in the context of the present invention must be transversely extensible (page 24, line 6) and have a low enough modulus of elasticity to permit an improved gasketing action under loading (stress) during ordinary usage within an absorbent article. Applicants further noted that it would be understood by the person having ordinary skill in the art that such materials as McCormack teaches may have to be modified to meet the criteria of the present invention (page 25, line 8).

Without implication as to the meaning or breadth of claims in the McCormack reference, after careful study Applicants do not believe that the reference discloses the limitations of the present invention sufficiently to direct the person of ordinary skill in the art to the present invention as a whole. Because McCormack contains no discussion or suggestion of a desired Young's modulus in either axis, it cannot *prima facie* suggest to the person having ordinary skill in the art the invention as presently claimed. Applicants also refer to the discussion of the Detailed Action at page 6, first full paragraph, wherein McCormack is deemed to be "capable of having" the claimed modulus of elasticity. Any suggestion that McCormack makes the presently claimed invention obvious, merely through the use of similar starting materials at some generic level, would require impermissible hindsight to achieve the present invention. The situation is analogous to the builder of ships and the builder of cars both starting with steel as a major component of the body work. However, each builder ends with a

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recognizably distinct and non-interchangeable product according to the teachings of his art.

Claims 2, 4 and 8 as dependent from Claim 1 and incorporating all limitations thereof, are also allowable. Applicants therefore respectfully request that all of the present rejections be withdrawn.

Per paragraph 10 of the Detailed Action, Claims 1, 6, 9, 10, 15, 16 and 25 stand rejected as obvious over Buell (US Patent 5,085,654 hereinafter "Buell"). Claims 1 and 9 specifically recite a material for a containment flap within the context of the present invention suitably having a low enough modulus of elasticity in one axis and a high enough modulus of elasticity in a second axis to permit an improved gasketing action under loading during ordinary usage within an absorbent article, per the above discussion with respect to McCormack. No corresponding teaching of such a containment flap is shown in Buell. All remaining Claims under discussion are dependent from and incorporate the limitations of Claims 1 and 9. Therefore, the presently amended Claims are not rendered obvious by Buell. Applicants therefore respectfully request that the present rejections be withdrawn.

Per paragraph 11 of the Detailed Action, Claim 5 is rejected as obvious over McCormack in view of Morman, US Patent 5,226,992 (hereinafter "Morman"). It is the contention of the Detailed Action that the two references are properly combined to make the present invention obvious because supplying McCormack with the claimed percentage of necking requires only routine skill in the art and because Morman teaches that the necked percentage (45%) is desired.

Without implication as to the meaning or breadth of claims in the either of the references, after careful study Applicants do not believe that the references disclose the limitations of the present invention sufficiently to direct the person of ordinary skill in the art to the present invention as a whole. The proffered motivation of the Detailed Action presupposes that McCormack teaches the desirability of attaining the (low) level

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of Young's modulus in one axis to maintain extension of the gasket material as taught by the presently claimed invention. However, as discussed above, McCormack is apparently unconcerned with a low level Young's modulus for maintaining extension. It also appears that Morman's teachings are directed to a material with a higher level of recovery (see e.g., col. 9, line 25) and therefore a high Young's modulus (see e.g., col. 14, line 45 for the much higher "modulus of elongation" numbers for the elastic sheet component of Morman's laminate). Morman's teaching of elastic limits, or stretch limits, or both, provide no further impetus for the combination of McCormack and Morman to achieve the structure or effect of the present invention. Therefore, only with the benefit of hindsight and using the present Claims as a template, could the cited references be combined to achieve the present invention. Applicants therefore respectfully request that the present rejections be withdrawn.

Per paragraph 12 of the Detailed Action, Claims 9, 11-12, 14, and 17-24 are rejected as obvious over McCormack in view of Sauer (US Patent 5,938,652, hereinafter "Sauer"). Without implication as to the meaning or breadth of claims in the either of the references, after careful study Applicants do not believe that the references disclose the limitations of the present invention sufficiently to direct the person of ordinary skill in the art to the present invention as a whole. Sauer teaches a rear waist flap with elasticized ends and a substantially inelastic center area. Applicants respectfully submit that Sauer contains no teachings sufficiently regarding the different axes' moduli per the limitations of Claim 9, upon which the remaining Claims depend. Sauer instead appears to teach zones of elasticity and inelasticity along one axis of its waist panel material. Applicants reiterate their comments with respect to the lack of concern for low modulus extensibility by McCormack. Thus, neither reference, singly or in combination, provides impetus for the combination to achieve the structure or effect of the present invention as a whole. Applicants therefore respectfully request that the present rejections be withdrawn.

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For all the foregoing reasons, the Claims as presently amended are believed to be allowable over the art of record. A notice to that effect is earnestly solicited.

Request For Telephonic Interview

Clearly, there are differences between the present invention and the cited reference(s) involving patentable subject matter. These differences are believed by the Applicants to be properly defined in the present Claims. The Examiner is requested to call Applicants' attorney (per the provisions of M.P.E.P. § 713) to discuss any further problems or suggest solutions in defining the present invention in order to expedite the case towards allowance.

Favorable consideration is requested.

Respectfully submitted,



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